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Barbara A Gilcrest

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HOWREY LLP - East

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EXAMINER

ZARA, JANE J

ART UNIT

PAPER NUMBER

1635

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PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

|                              |                                      |   |  |
|------------------------------|--------------------------------------|---|--|
| <b>Office Action Summary</b> | <b>Application No.</b><br>10/553,001 | <b>Applicant(s)</b><br>GILCHREST ET AL. |  |
|                              | <b>Examiner</b><br>Jane Zara         | <b>Art Unit</b><br>1635                 |  |

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 1 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 11 October 2005.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-83 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☐ Claim(s) \_\_\_\_\_ is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☒ Claim(s) 1-83 are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)                     | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____                                      |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)          | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____  | 6) <input type="checkbox"/> Other: _____                          |

***Election/Restrictions***

Restriction is required under 35 U.S.C. 121 and 372.

This application contains the following inventions or groups of inventions which are not so linked as to form a single general inventive concept under PCT Rule 13.1.

In accordance with 37 CFR 1.499, applicant is required, in reply to this action, to elect a single invention to which the claims must be restricted.

Group I, claim(s) 1-3, 6-22, drawn to methods of screening for Mre11 modulators.

Group II, claim(s) 4, 5, 8, 9, drawn to methods of screening for agents that bind to Mre11.

Group III, claim(s) 23-26, 29-45, drawn to methods of screening for tankyrase modulators.

Group IV, claim(s) 27, 28, 31, 32, drawn to methods of screening for agents that bind to tankyrase.

Group V, claim(s) 46-49, drawn to methods of screening for modulators of MRN complex formation.

Group VI, claim(s) 50-62, drawn to methods of screening for modulators of the DNA damage pathway.

Group VII, claim(s) 63, 69, drawn to methods of treating cancer.

Group VIII, claim(s) 64, 69, drawn to methods of inducing apoptosis.

Group IX, claim(s) 65, 69, drawn to methods of inducing cellular senescence.

Group X, claim(s) 66, 69, drawn to methods of inhibiting tanning.

Group XI, claim(s) 67, 69, drawn to methods of promoting cellular differentiation.

Group XII, claim(s) 68, 69, drawn to methods of promoting immunosuppression.

Group XIII, claim(s) 70, 77, drawn to methods of inhibiting apoptosis.

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Group XIV, claim(s) 71, 77, drawn to methods of inhibiting cellular senescence.

Group XV, claim(s) 72, 77, drawn to methods of promoting growth.

Group XVI, claim(s) 73, 77, drawn to promoting tanning

Group XVII, claim(s) 74, 77, drawn to methods of inhibiting cellular differentiation.

Group XVIII, claim(s) 75-77, drawn to methods of reducing cancer treatment side effects.

Group XIX, claim(s) 78-83, drawn to nucleic acid compositions.

The inventions listed as Groups I-XIX do not relate to a single general inventive concept under PCT Rule 13.1 because, under PCT Rule 13.2, they lack the same or corresponding special technical features for the following reasons:

Claims 1-83 are drawn to methods utilizing a plurality of assays. Therefore, this application does not comply with the requirements for unity of invention (Rules 13.1, 13.2 and 13.3) for the following reasons:

According to the guidelines in section (f)(i)(a) of annex B of the PCT Administrative Instruction, the special technical feature as defined by PCT Rule 13.2 shall be considered to be met when all the alternatives of a Markush group are of similar nature. For chemical or biological alternatives, such as the claimed assays including cellular proliferation, cellular viability, cellular morphology, SA- $\beta$ -Gal activity, or phosphorylation of p53 or p95, the Markush groups shall be regarded as being of similar nature when (A) all alternatives have common property or activity AND (B)(1) a common structure is present, i.e., a significant structure is shared by all the alternatives OR (B)(2) in cases where the common structure cannot be the unifying criteria, all

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alternatives belong to an art recognized class of compounds in the art to which the invention pertains.

The instant assays, phenotypes, biological effects, etc. set forth in and/or encompassed by claims 1-83 are considered to be each separate inventions for the following reasons:

The different assays, biological effects and phenotypes do not meet the criteria of (A), common property or activity or (B)(2), art recognized class of compounds. In the instant case, the different assays including cellular proliferation, cellular viability, cellular morphology, SA- $\beta$ -Gal activity, or phosphorylation of p53 or p95 are structurally and chemically and biologically different and distinct, and the assays measure different phenotypes, biochemical and biological effects. Each member of the class cannot be substituted one for the other with the expectation that the same intended result would be achieved or measured.

Further, the Groups of different methods do not meet the criteria of (B)(1) as they do not share, one with another, a common core structure. Accordingly, unity of invention between the assays including cellular proliferation, cellular viability, cellular morphology, SA- $\beta$ -Gal activity, or phosphorylation of p53 or p95 is considered to constitute a special technical feature.

Applicant is therefore advised to elect a single assay or phenotype with the corresponding elected Group.

Applicant is advised that the reply to this requirement to be complete must include (i) an election of a species or invention to be examined even though the

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requirement be traversed (37 CFR 1.143) and (ii) identification of the claims encompassing the elected invention.

The election of an invention or species may be made with or without traverse. To reserve a right to petition, the election must be made with traverse. If the reply does not distinctly and specifically point out supposed errors in the restriction requirement, the election shall be treated as an election without traverse.

Should applicant traverse on the ground that the inventions or species are not patentably distinct, applicant should submit evidence or identify such evidence now of record showing the inventions or species to be obvious variants or clearly admit on the record that this is the case. In either instance, if the examiner finds one of the inventions unpatentable over the prior art, the evidence or admission may be used in a rejection under 35 U.S.C.103(a) of the other invention.

### ***Conclusion***

Certain papers related to this application may be submitted to Art Unit 1635 by facsimile transmission. The faxing of such papers must conform with the notices published in the Official Gazette, 1156 OG 61 (November 16, 1993) and 1157 OG 94 (December 28, 1993) (see 37 C.F.R. ' 1.6(d)). The official fax telephone number for the Group is 571-273-8300. NOTE: If Applicant does submit a paper by fax, the original signed copy should be retained by applicant or applicant's representative. NO DUPLICATE COPIES SHOULD BE SUBMITTED so as to avoid the processing of duplicate papers in the Office.

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Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jane Zara whose telephone number is (571) 272-0765. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, James Douglas Schultz, can be reached on (571) 272-0763. Any inquiry of a general nature or relating to the status of this application should be directed to the Group receptionist whose telephone number is (703) 308-0196.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

**Jane Zara**  
**3-27-09**

/Jane Zara/  
Primary Examiner, Art Unit 1635